

REMARKS

Reconsideration and allowance of this application are respectfully requested. Claims 3-5, 9-11, 15 and 17 have been amended. Claims 1-18 are pending in the application. The rejections are respectfully submitted to be obviated in view of the remarks presented herein.

Objection to the Specification

The specification has been objected to because it allegedly appears to be a literal translation of a foreign document. Applicants believe that the as-filed specification is in proper idiomatic English, and are not aware of any instances of improper idiomatic English. Applicants also believe that the as-filed specification is in compliance with 37 C.F.R. § 1.52(a) and (b). Although reference is made on page 21 of the specification to “kana reading information,” this particular type of information is solely an exemplary embodiment of a type of content contained in a correspondence information piece T, as disclosed in the specification on page 21, lines 13-19. Applicants’ disclosure of this exemplary embodiment does not render the specification to be in improper idiomatic English. Therefore, withdrawal of the objection to the specification is respectfully requested.

Objection to the Claims

Claim 15 has been objected to because of informalities. Applicants have editorially amended claim 15 to correct a typographical error, as suggested by the Examiner. Therefore, withdrawal of the objection to the claims is respectfully requested.

Rejection Under 35 U.S.C. § 112, Second Paragraph

Claims 1-18 have been rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The rejection is respectfully traversed.

Applicants believe that the claims are in proper idiomatic English, adhering to all requirements of 35 U.S.C. § 112, and are not aware of any instances of grammatical or idiomatic errors. Applicants also believe that the claims are not indefinite, and are clear in pointing out and distinctly claiming exemplary embodiments of the present invention. For example, claim 1 recites a server, comprising a storage section, a corresponding information storage section, an output section, and a storage control section. Claim 7 recites a terminal, comprising a storage section, an acquisition section, a utilization section, an update section, and a return section. Claim 13 recites an information processing system, comprising a server and a terminal, wherein the server comprises a first storage section, a corresponding information storage section, an output section, and a storage control section, and the terminal comprises a second storage section, an acquisition section, a utilization section, an update section, and a return section. Amended claim 15 recites “a computer-executable server program embodied on a computer-readable medium, the computer-executable server program causing a server computer contained in a server to function as a storage section, a corresponding information storage section, an output section, and a storage control section. Amended claim 17 recites a computer-executable terminal program embodied on a computer-readable medium, the computer-executable terminal

program causing a terminal computer contained in a terminal to function as a storage section, an acquisition section, a utilization section, an update section, and a return section.

Regarding claims 6 and 12, Applicants have editorially amended claims 6 and 12 to improve clarity. Support for these claim amendments is found in the specification on at least page 50, lines 10-23.

Regarding claims 1, 7, 13, 15 and 17, exemplary embodiments of a plurality of second information pieces stored in one-to-one correspondence with a plurality of first information pieces is clearly described and shown in the specification on at least page 20, line 23 to page 21, line 9, and in FIG. 3.

Regarding claims 1, 7, 13, 15 and 17, an exemplary embodiment of a second information piece is shown in FIG. 2(a). As shown in FIG. 2(a), a correspondence information piece T contains information indicating the contents or attribute of the piece of music M to which the correspondence information piece T corresponds. The information pieces (20-28) as shown in FIG. 2(a) are non-limiting exemplary embodiments of the content information pieces or attribute information pieces as claimed.

Regarding claims 1, 13 and 15, the second information piece is output by an output section of a server. Additionally, the outputted second information piece is returned to the server from a terminal. Therefore, the outputting and returning of the second information piece is clearly defined by each of claims 1, 13 and 15.

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Regarding claims 3 and 9, Applicants have editorially amended claims 3 and 9 to improve clarity. Support for these claim amendments is found in the specification on at least page 22, line 23 to page 24, line 12. Furthermore, the outputting and returning of the batch information to/from the terminal is clearly defined by each of claims 3 and 9.

Regarding claims 4, 5, 10 and 11, Applicants have editorially amended claims 4, 5, 10 and 11 to improve clarity. Support for these claim amendments is found in the specification on at least page 22, line 23 to page 24, line 16.

Reconsideration and withdrawal of the rejection under 35 U.S.C. § 112, second paragraph, are respectfully requested.

Rejection Under 35 U.S.C. § 101

Claims 15-18 have been rejected under 35 U.S.C. § 101, as allegedly being directed to non-statutory subject matter. Applicants have amended claims 15 and 17 to encompass computer-executable programs embodied upon computer-readable mediums. In particular, amended claim 15 now recites “[a] computer-executable server program embodied on a computer-readable medium, the computer-executable server program causing a server computer contained in a server to function as: a storage section ...; a corresponding information storage section ...; an output section ...; and a storage control section.” Amended claim 17 now recites “[a] computer-executable terminal program embodied on a computer-readable medium, the computer-executable terminal program causing a terminal computer contained in a terminal to function as: a storage section ...; an acquisition section ...; a utilization section ...; an update

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section ...; and a return section.” Reconsideration and withdrawal of the rejection under 35 U.S.C. § 101 are respectfully requested.

Rejection Under 35 U.S.C. § 102(b) - Herz et al.

Claims 1-18 have been rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Herz et al. (U.S. Patent Number 5,758,257; hereinafter “Herz”). The rejection is respectfully traversed.

Regarding claim 1, an exemplary embodiment of the invention relates to a server comprising a storage section, a corresponding information storage section, an output section, and a storage control section. The storage section stores a plurality of first information pieces. The corresponding information storage section stores a plurality of second information pieces in one-to-one correspondence with the plurality of the first information pieces, the second information pieces including content information pieces indicating contents of the first information pieces or attribute information pieces indicating attributes of the first information pieces. The output section outputs the first information pieces to be outputted to a terminal together with the second information pieces corresponding to the first information pieces to be outputted. Further, when the outputted second information piece is returned from the terminal, the storage control section stores the returned second information pieces in place of the second information pieces before outputting in the corresponding information storage section.

The disclosure of Herz does not anticipate the claimed invention. Herz discloses a system and method of scheduling the receipt of desired data from a network which

simultaneously distributes many sources of data to many customers. An agreement matrix characterizes the attractiveness of each data to each prospective customer, and is calculated by comparing the recipient's profiles to actual profiles of the characteristics of the available data. Virtual channels are determined which contain a collection of programs which best match the customer's profile (determined to be more desirable). In such a way, most desirable programming is matched to a particular customer's objective preferences.

However, Herz's content profiles only describes the contents of video programs, and are used for mathematical comparison to customer profiles to generate the agreement matrix (column 10, lines 6-16). There is no teaching or suggestion in Herz of any plurality of second information pieces which are in one-to-one correspondence with a plurality of first information pieces. Furthermore, there is also no teaching or suggestion in Herz of outputting the first information pieces and corresponding second information pieces to a terminal, and where a storage control section in the server stores second information pieces which have been returned from the terminal. The returned second information pieces are stored in place of the second information pieces before outputting in the corresponding information storage section.

Herz's profiles are not disclosed or suggested to have a one-to-one correspondence with first information pieces, nor are does Herz disclose an output section which outputs the first information pieces to a terminal together with the second information pieces. Further, Herz's agreement matrix does not function such as to store returned second information pieces in place of the second information pieces before outputting in the corresponding information storage

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section, whereby the returned second information pieces are the outputted second information pieces returned from the terminal to the server.

Therefore, Herz fails to teach or suggest the claimed invention, as recited by claim 1. At least by virtue of the aforementioned differences, the claimed invention distinguishes over Herz. Claims 2-6 are dependent claims including all of the elements of independent claim 1, which as established above, distinguishes over Herz. Therefore, claims 2-6 are allowable over Herz for at least the aforementioned reasons as well as for their additionally recited features. Reconsideration and withdrawal of the rejection under 35 U.S.C. § 102(b) are respectfully requested.

Regarding claim 7, an exemplary embodiment of the invention relates to a terminal comprising a storage section, an acquisition section, a utilization section, an update section and a return section. Herz fails to teach or suggest the claimed invention for analogous reasons as described above. Claims 8-12 are dependent claims including all of the elements of independent claim 7, which as established above, distinguishes over Herz. Therefore, claims 8-12 are allowable over Herz for at least the aforementioned reasons as well as for their additionally recited features. Reconsideration and withdrawal of the rejection under 35 U.S.C. § 102(b) are respectfully requested.

Claims 13, 15 and 17 disclose a related system, server program, and terminal program respectively, and are allowable over Herz for analogous reasons as described above. Claims 14, 16 and 18 are dependent claims including all of the elements of independent claims 13, 15 and

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17 respectively, which as established above, distinguish over Herz. Therefore, claims 14, 16 and 18 are allowable over Herz for at least the aforementioned reasons as well as for their additionally recited features. Reconsideration and withdrawal of the rejection under 35 U.S.C. § 102(b) are respectfully requested.

Double Patenting Rejection of Claim 1

Claim 1 has been rejected under the judicially created doctrine of double patenting over claim 1 of U.S. Patent Number 6,831,798 (Hayashi). The rejection is respectfully traversed.

The Examiner contends that both the instant application and Hayashi disclose the storing of a plurality of information including a first partial information and a second partial information and reproducing the partial informations. However, Hayashi discloses specifically the reproduction of information, in which a plurality of informations is stored, and the plurality of informations includes a first partial information and a second partial information. The first partial information of information of arbitrarily selection information is read out and reproduced, and the second partial information is read out during reproduction of the first partial information, and the read out second partial information is reproduced.

Conversely, Applicants' claim 1 recites a storage section which stores a plurality of first information pieces, and a corresponding information storage section which stores a plurality of second information pieces in one-to-one correspondence with the plurality of first information pieces. The second information pieces include content information pieces indicating contents of the first information pieces or attribute information pieces indicating attributes of the first

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information pieces. Applicants' claim 1 also recites an output section which outputs the first information pieces to be outputted to a terminal together with the second information pieces corresponding to the first information pieces to be outputted. Furthermore, when the outputted second information piece is returned from the terminal, a storage control section stores the returned second information pieces in place of the second information pieces before outputting in the corresponding information storage section.

Applicants maintain that the server recited by claim 1 is not disclosed or suggested by Hayashi, and the double patenting rejection is improper. In particular, the storage control section of the server stores returned second information pieces in place of the second information pieces before outputting in the corresponding information storage section, as recited by claim 1. These claimed elements are not at all taught or suggested by Hayashi, nor does Hayashi's reproduction or partial informations even remotely refer to or suggest second information pieces in one-to-one correspondence with a plurality of first information pieces and including content information pieces or attribute information pieces, but instead only mentions the storing and reproduction of partial information.

At least by virtue of the aforementioned differences, the claimed invention is not at all disclosed by Hayashi. Reconsideration and withdrawal of the double patenting rejection of claim 1 are respectfully requested.

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Double Patenting Rejection of Claims 1 and 6

Claims 1 and 6 have been provisionally rejected under the judicially created doctrine of obviousness-type double patenting, however, it is unclear as to which claim of copending U.S. Patent Application Number 10/015,566 (Hayashi et al.) this rejection is based on. Furthermore, the copending application to Hayashi et al. appears to be abandoned due to inaction and failure to respond to the Office Action of June 22, 2005, and thus can not be used as a basis of a double patenting rejection. Additionally, although the copending application to Hayashi et al. discloses in claim 1 a server comprising a storage section, a corresponding information storage section and an output section, there is no teaching or suggestion of a storage control section which stores the second information pieces in place of the second information pieces before outputting in the corresponding information storage section, wherein the second information pieces to be stored by the control section had been outputted by the output section and returned from the terminal. Therefore, reconsideration and withdrawal of the double patenting rejection of claims 1 and 6 are respectfully requested.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

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The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Lenny R. Jiang', written over a horizontal line.

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